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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,903	10/27/2000	Brigitte Weston	514412-2020.1	8217

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EXAMINER

MOONAN, FRANCIS P

ART UNIT PAPER NUMBER

1638

DATE MAILED: 12/14/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/698,903

Applicant(s)

WESTON ET AL.

Examiner

Francis P Moonan

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Application No. 09/698,903 filed on 27 October 2001 is a Continuation-In-Part of Application No. 09/430,497 filed on 29 October 1999.

#### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Group I. Claims 1-7 and 11-12, drawn to transgenic *Brassica* plants, seeds, or parts thereof, the genomes of which are capable of producing diagnostic restriction fragment length polymorphisms with Southern blot assays with plant genomic DNA and probes consisting of SEQ ID NO: 1, 2 or 3; and/or transgenic *Brassica* plants, seeds, or parts thereof, the genomes of which are capable of producing diagnostic DNA fragments produced by PCR amplification with plant genomic DNA and synthetic primers having the nucleotide sequence of SEQ ID NO: 11 or 12, classified for example in class 800, subclass 278.
- Group II. Claims 8-10, 13-16, and 19-22, drawn to a male-sterile transgenic *Brassica* plant, seed, or parts thereof characterized with molecular markers, progeny of said plant, and a method of identifying said plant with molecular markers, classified for example in class 800, subclass 303.
- Group III. Claims 17-18, drawn to kits comprising at least two PCR-derived probes, classified for example in class 536, subclass 24.3.

The inventions are distinct, each from the other because:

The inventions of Groups I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the inventions of Groups I and II have different structural composition, different method steps, different modes of operation, and different functions. The invention of Group I encompasses *Brassica* plants transformed with a multitude of transgenes conferring a multitude of phenotypes unrelated to male sterility, each not required by the invention of Group II. The

Art Unit: 1638

invention of Group II consists of a male-sterile plant comprising a male sterility gene wherein said male sterile plant product or male sterility gene is not required of the invention of Group I. The invention of Group II has differences in plant male fertility structure not required of the invention of Group I. The invention of Group II has different modes of physiological operation leading to a male-sterility phenotype, that is not required of the invention of Group I. The invention of Group II consists of a method which includes phenotypic characterization and selection of plants that are male-sterile, whose steps are not required of the invention of Group I. Furthermore, the invention of Groups I and II perform different functions. The invention of Group II may be utilized as parentals to produce male-sterile plants for more efficient hybrid seed production, which is not a function required by the invention of Group I.

The inventions of Group III and Groups I-II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the kit invention of Group III may be independently used in diagnostic processes of plants unrelated to the plants of the inventions of Groups I and II.

Furthermore, the inventions of Groups I-III may be classified in distinctly different classes, and a search of all inventions would place an undue burden on the examiner.

Because these inventions are independent and distinct for the reasons stated above and have acquired a separate status in the art as shown by their different classification, the search for

Art Unit: 1638

one group is not required of the others, and a search of all of the Groups would place an undue burden of search on the examiner, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis Moonan, whose telephone number is (703) 605-1201. The examiner can normally be reached on Monday through Friday 9:00 AM to 5:00 PM (E.S.T.)

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310. The fax phone number for this Group is (703) 308-4315. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Francis Moonan, Ph. D.  
15 December 2001

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180-1638

